

Attorney Docket
33701 M 002



2165

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CONFIRMATION NO. 8638

Applicant : Heizo KITAJIMA
Serial No. : 09/391,459 Art Unit : 2165
Filed : September 8, 1999 Examiner : James H. Zurita
For : Client Card Mail System

LETTER TO THE EXAMINER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir :

An Office Action was issued April 21, 2004 in the above-referenced case. However, as received by the undersigned Attorney for Applicants, only the cover sheet of the Action is directed to application Serial No. 09/391,459. All the attached pages (Office Action Summary and pages 2-9) are directed to application Serial No. 09/429,603.

In accordance with the Examiner's advice in a telephone message to the undersigned, attached hereto is the original copy of the Office Action mailed April 21, 2004. The undersigned Attorney for Applicant understands that the Office Action issued in application No. 09/391,459 will be re-sent and that the time for response will be re-set.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

Michael A. Makuch, Reg. 32,263
1850 M Street, NW - Suite 800
Washington, DC 20036
Telephone : 202/263-4300
Facsimile : 202/263-4329

May 10, 2004

214957

Response Due
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,459	09/08/1999	HEIZO KITAJIMA	33701M002	8638

441 7590 04/21/2004

SMITH, GAMBRELL & RUSSELL, LLP
1850 M STREET, N.W., SUITE 800
WASHINGTON, DC 20036

EXAMINER

ZURITA, JAMES H

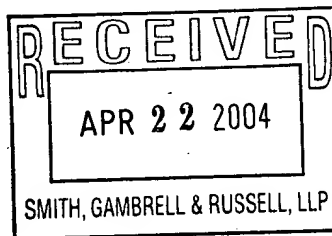
ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



DOCKET 633701.002
DOCKETED BY: KRB
DATE 4/22/04
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Office Action Summary



Applicati n No.

09/429,603

Applicant(s)

BULL ET AL.

Examiner

Khanh H. Le

Art Unit

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-73, 75-90, 92-107 and 109-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-73, 75-90, 92-107, 109-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

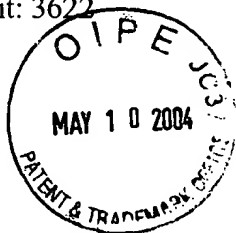
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Supplemental Response to RCE

1. This Office Action is Supplemental to the Office Action mailed on 11/14/03. Telephonic conversations with Mr. Andrew Spence are hereby acknowledged, the latest of which occurred on 4/14/2004. Some claims (67-68, 84-85, 101-102, 88, 105) inadvertently had not been addressed earlier and are herein addressed. It is noted that claim 71 was addressed earlier. Further, Claims 86 and 103 parallel claim 69, in computer medium and system format, respectively, not claim 82 and 103 as stated earlier. The prior of record remain the same. The following is essentially a repeat of the last Office Action with modifications addressing the above-cited claims or any other minor inconsistencies in bold or under-lined where appropriate.

A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 26, 2003 has been entered.

This Office Action is in response to the RCE and Amendment dated August 26, 2003. Claims 65-115 were presented for examination. Claims 74, 91, 108 have been cancelled. Claims 65-73, 75-90, 92-107, 109-115 are presently presented for examination. Claims 65, 82, 99 are independent.

Response to Remarks

2. In view of the amendments to the independent claims, all rejections under 35 USC 102, using Goheen, US 5724520, are withdrawn and arguments related to Goheen are thus moot.

As to Baker III, US 5864822, however, Applicants' remarks have been carefully considered but are deemed unpersuasive.

Applicants' arguments (at p. 14 , 2nd paragraphs) re. the Baker III 'benefits' not being able of interpretation as "advertising information" are unpersuasive.

According to Merriam-Webster On-line, <http://merriamwebster.com>
"to advertise" means

"1 : to make something known or to notify

and “advertisement” means *1 : the act or process of advertising.*

Herein “advertising information” is interpreted as equivalent to “advertisement”.

Further, according to Merriam-Webster On-line, “to advertise” has also a narrower meaning

2c: to call public attention to especially by emphasizing desirable qualities so as to arouse a desire to buy or patronize. A synonym would be to **PROMOTE** which means

2c : to present (merchandise) for buyer acceptance through advertising, publicity, or discounting

The Examiner notes that during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Prater*, 162 USPQ 541 (CCPA 1969).

Therefore “advertising information” can simply be interpreted as a notification.

The Baker consumer is notified (i.e. “advertised to”) of a benefit which has “some potential usefulness” to him who is “contemplating a particular purchase of goods or services” (Baker, col 5 l. 45-55). Thus the benefit is “advertising information”.

Further, as argued at page 13, Baker, at col 4, l. 35-37, mentions a “benefit” as “not generally available to the public”. However, the Baker consumer is also a member of the public, albeit a more select public. He is notified (i.e. “advertised to”) of a benefit which has “some potential usefulness” to him who is “contemplating a particular purchase of goods or services”. (Baker, col 5 l. 45-55). Thus the “benefit” serves “to call itself to his attention, especially by emphasizing desirable qualities so as to arouse a desire to buy or patronize”, which would also fit the second and more narrow meaning of “to advertise” which is synonymous to “to promote”, as cited above. Thus again, even under this interpretation of “advertising information”, as the benefit is “offered” (Baker, abstract) for the consumer’s contemplation, the benefit is “advertising information”.

Applicants’ arguments at p. 15, first paragraph as to why Baker should not be modified with ads are unpersuasive: Applicants admit (Applicants’ arguments at p. 15, 1st paragraph) that some ads which include coupons also provide added value, which is compatible with the Baker promotion of added values system. Further targeted advertisements are well-known, (one just has to cursorily look at the number of patents in Patent Class/subclass 705/14 that are devoted to that subject) therefore there is no conflict in serving targeted ads in addition to or as “benefits” to the Baker consumer.

Applicants further argue (at p. 15-page 16) there’s no motivation to combine Baker with Reilly. This is unpersuasive. First, the Baker “benefits” are themselves ads as discussed above. In the context of ads serving, the teachings of Reilly to track ad interactions and reporting to

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advertisers the ad interaction success rate would be highly relevant and obvious to one skilled in the art to add to Baker to achieve the advantage taught by Reilly.

As to claim 73, Officially Noted facts were not seasonally challenged by Applicants therefore are taken as admitted. MPEP § 2144.03.

Continuity

3. The Examiner maintains that proper support for all claims now presented reside in the new matter section of the specifications, filed as of 10/29/1999 only.

Nowhere in the specifications of parent applications SN 08/685805 or 08/87668 (issued patents 5901287, 6208975 respectively), can “detecting a purchase event associated with a consumer” be found.

Claim Rejections - 35 USC § 101

4. Rejections of Claims 65-77 under this section are withdrawn due to the amendments.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 65-66, 67-68, 69-70, 71-72, 77-78, 81; 82-83, 84-85, 86-87, 88-89, 94-95, 98; 99-100, 101-102, 103-104, 105, 106, 112-113, 115 are rejected under 35 U.S.C. 102(e) as being anticipated by Baker, III, US 5864822, hereinafter Baker.

As to claims 65, 66, 69, and 81 Baker discloses:
A method for delivering itinerary information comprising:
detecting a travel reservation (purchase event)associated with a consumer
(col 8,l. 39 and seq. ,consumers making travel plans through the reservation system 34...”; Fig 3 and associated text :) ;

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retrieving itinerary information from a database, wherein the itinerary information is retrieved based on the purchase event

(col 6 l. 3 – 57 read with col 8,l. 60 to col 9 l. 3: itinerary is interpreted as being retrieved from the air travel reservation system instead of being inputted by user ; Fig 3 and associated text; (col 5, l. 61 et seq., “location where the consumer required lodging “and “the time frame ...needed ” is such travel itinerary data) ,

and includes merchant information matched to at least one aspect of the purchase event (col 5, l. 61 et seq., in particular col 6 l. 15-18 : the benefits that match the itinerary needs are displayed, those benefits include the providing merchants information, thus “merchant information”) ;

formatting the itinerary information(col 6 l. 19- 41, different formats)

; and

providing the formatted information to the consumer

(col 5, l. 61 et seq., the benefits including the providing merchants, or “merchant information” that match the itinerary needs are displayed)

Further, Baker discloses

wherein the merchant information comprises advertising information.

(Baker, col 5 , l. 49 et seq.: a benefit is also an ad; Fig 1, item 26 and associated text; col 6 l. 2-18, col 7 l. 4 –6: “discounts and benefits”). Also see explanations in the Response to Remarks section above.

Claims 82-83 and 99-100 parallel claims 65-66 in computer medium and system format, respectively, and are rejected on the same basis.

Claims 86 and 103 parallel claim 69, in computer medium and system format, respectively, and are rejected on the same basis.

Claims 98 and 115 parallel claim 81, in computer medium and system format, respectively, and are rejected on the same basis.

As for claims 67, 68, Baker discloses

The itinerary information is related to the consumer car rental reservation, or hotel reservation (see at least col. 5, l. 61 et seq., col. 6 lines 25-30, regarding hotels and lodging).

Claims 84-85, 101-102 parallel claims 67-68, in computer medium and system format, respectively, and are rejected on the same basis.

As to claim 70, (the method of claim 65, wherein the detecting further comprises identifying a request for the “itinerary information”) Baker discloses a user-query based search of relevant information (discounts/benefits) which are related to the planned travel, and thus interpreted as “itinerary information”.

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(As to Claim 71 dependent on 70, Baker discloses:

The detecting step is identifying a request for the travel itinerary information and the request includes the consumer ID information and the retrieving step includes accessing a database for a passenger name record (PNR) associated with the consumer using the ID information. (Fig 2 item 38 and associated text)

Claims 88, 105 parallels claim 71 , in computer medium and system format, respectively, and are rejected on the same basis.

As to Claim 72,

The method of claim 65, wherein the retrieving further comprises Matching merchant information to the purchase event based on a set of predefined interests associated with the customer.

Baker, at col 7 l. 32-37, col 6 l. 58 et seq.; preferences as to goods and services, col 5 l. 61 et seq., preferences as to hotel accommodations , col 6 l. 15-20 : preferences as to travel arrangements.

As to claims 77, 78 ,

Baker at col 9 l. 50 discloses

The method of claim 65 further comprising prior to providing the formatted itinerary information , transmitting the notification message to the consumer indicating the existence of the formatted itinerary information and with the targeted information being part of the electronic message (Baker: message informing user of benefit.)

7. Claims 87, 89, 94-95; 104, 106, 112-113 parallel claims 70, 72, 77-78 in computer medium and system format, respectively, and are rejected on the same basis.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found .

9. Claims 73, 90, 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker.

Claim 73. Baker does not specifically disclose providing the targeted information to the consumer prior to delivery of a purchased item associated with the purchase event. However Official Notice is taken that it is well-known to market related products and services to a consumer who recently purchase an item. Examples would be selling maintenance contracts to

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recent appliances or automobiles purchasers. One skilled in the arts would have known to include such well-known marketing techniques in the Baker system because such cross-sell and upsell marketing techniques are proven successful income generating ones.

Also it can be interpreted that Baker provides the itinerary/merchants information before the customer travels (delivery of the purchased item) thereby “providing the targeted information to the consumer prior to delivery of a purchased item associated with the purchase event”.

The additional limitation in claims 90, 107 parallel that of claim 73 and are rejected on the same basis.

10. Claims 75-76, 92-93, 109-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Reilly, US 5754549.

Claim 75. The method of claim 65 is disclosed above.

Further, Reilly col 5 l 61 –col 6 l. 10, discloses tracking consumer ad interactions and reporting to advertisers as well as updating (generating) a profile on the consumer based upon the recorded consumer response. (col 9 l. 17-33). One skilled in the arts would have known to add Reilly’s disclosed feature to Baker’s ads delivery system to allow ads success feedbacks to advertisers as taught by Reilly.

Claim 76. The method of claim 75 is disclosed above.,

Reilly, Fig 1 item 138 and 148 and associated text; col 5 l 61 –col 6 l. 6, further discloses tracking ad interactions and reporting to advertisers (documenting information related to advertisement impressions and interactive responses to the formatted itinerary information). One skilled in the arts would have known to add Reilly’s disclosed feature to Baker’s ads delivery system to allow ads success feedbacks to advertisers as taught by Reilly.

Applicants argue (at p. 15-page 16) there’s no motivation to combine Baker with Reilly. This is unpersuasive. First, the Baker “benefits” are themselves ads as discussed above. In the context of ads serving, the teachings of Reilly to track ad interactions and reporting to advertisers the ad interaction success rate would be highly relevant and obvious to one skilled in the art to add to Baker to achieve the advantage taught by Reilly.

Claims 92-93, 109-110 parallel claims 75-76 in computer medium and system format and are rejected on the same basis.

11. Claims 79-80, 96-97, 113-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Van Dusen, US 6175823 B1.

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As for claims 79-80,

The method of claim 77 is disclosed above.

Further, Van Dusen discloses, wherein the notification message comprises an electronic message including a pointer which is a link associated with a network location for the information source (col 6 l. 35-60). One skilled in the arts would have known to include the Van Dusen linked e-mail disclosure in the Baker's system to provide easy access to the targeted information.

Claims 96-97, 113-114 parallel that of claims 79-80 and are rejected on the same basis.

Conclusion

12. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kanevsky et al., US 6334109 B1, discloses personalized advertisements displayed or printed on sales receipts, including ticket sales, with personalization based on a current transaction. This reference could be used to reject most claims, at least, under 35 USC 103(a).

*WO 95/17733 to OHRN, Harald, discloses booking reservations and information as to the booking being stored and retrieved

*Filepp et al, US 5347632, discloses monitoring of user characteristics to generate specific ads based on usage characteristics and predetermined interests

Herz et al, US 5754939 discloses identification of target profiles from user activity, user requests, analysis of content interacted with and ads insertion

Dedrich, US 5724521, col 7, l. 1-36, Fig 2, item 24; Fig 3, item 30, Fig 7b item 218; and associated text, discloses recording a response of the consumer to the targeted information; and updating user profiles; Dedrich also discloses recording user interacting with the ads and such data is transferred back to the advertiser (col 8 l. 53-col 9 l. 48). Dedrich could be used to reject claim 7 and the likes. Dedrich also discloses matching ads with desirable consumer profiles (Fig 7a) before distribution of the ads.

Fano, US 6317718B1 discloses monitoring of user actions (col 7, Fig 25), delivery of customized offers presented to consumers based on stated interest and updated location data.

Shoolery et al, US 5570283, discloses A system for controlling travel primarily in a corporate environment that interconnects travelers, travel agents and airline CRSs so that a traveler can communicate with the CRS with a user friendly GUI to obtain schedule information and

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transfer such to a travel agent, the travel agent can use the selected schedule information for ticketing and to assure the lowest cost while the entire trip information is stored locally for management control. The system includes multiple connects to the CRS to overcome data transfer limitations specific to airline CRSs

Garback, 5237499, discloses A computer based system for processing travel requests directed to a specific venue from individual members of a sponsored group. The system comprises a data base containing a venue file including information regarding the specific venue, a group member file for each individual member of the group, a travel policy file containing information on preselected vendors of various travel services, and a city code file containing codes corresponding to a plurality of city airport locations. Data is entered and information displayed to an individual group member making a travel request via a terminal, such as a personal computer. A central processing unit is in communication with the data base and with a plurality of airline CRS systems. The CPU is programmed to select an individual group member itinerary for the specific venue which includes specific airline flights, and if necessary, specific hotel accommodations and specific rental car services.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

April 15, 2004

KHL

KHL


JAMES W. MYHRE
PRIMARY EXAMINER

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set amount, M, of said good....” One of ordinary skill in the art at the time the invention was made to combine Anderson and knowledge generally available would have been motivated to disclose applicant's “...relation $M = A \times R$, where A is the sales amount of said good, and R is the sales rate of said good, and wherein said means [] for retrieving results extracts high-ranking clients for said single designated good by determining a few purchasers who contributed to purchase of said set amount, M, of said good....”

For the obvious reason that to determine information such as which customer(s) spend the most money for a particular specific product, retailers apply various types of formulas. In particular, one may wish to apply a sales amount for the specific product and its sales rate over a period of time to recognize trends. For example, a retailer may see that HEINZ 8 ounce bottles are dropping in sales. The retailer may decide to adjust the amount of shelf-space it gives for HEINZ 8 ounce bottles (specific product code 10086302145) and may even decide to discontinue HEINZ 8 ounce bottles (specific product code 10086302145).

As per new claims 8 and 10, Anderson does not specifically use the term *sales rate* to describe applicant's item 7h. Anderson does not specifically set sales to certain percentages, such as 80%. *Anderson does not* specifically define his high-ranking clients as those who contribute to sales of 80% of total sales of the goods. **Evans** discusses effective targeting of marketing and discloses the use of the Pareto principle, which suggests that transactional data must be tracked by a database and that actual purchase history is needed for analysis. According to **Evans**, Vilfredo Pareto's theory of

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income distribution has been transferred and borrowed by direct marketers to support the proposition that **80 per cent** of sales come from just 20 per cent of clients.

Therefore, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time the invention was made to combine *Anderson's* clustering over predetermined time periods with *Evans* discussion of the 80-20 rule to select subsets of clients and target these clients with mailings and promotions.

One of ordinary skill in the art of electronic commerce at the time the invention was made would have been *motivated* to combine *Anderson's* examples to retrieve high-ranking client data based on a percent of total sales, such as Pareto's 80-20 rule to select subsets of clients and target these clients with mailings and advertisements for the obvious reason that targeting the clients who buy the most is an efficient way to spend marketing budgets. Pareto's 80/20 rule provides an easy way of selecting highest ranking clients who would ultimately provide the bulk of a shop's revenue from a particular product. This is particularly important as companies downsize and must make more efficient use of decreasing resources.

Response to Amendment

By Amendment C, filed 9 September 2003, applicant amended claims 1, 6. By supplemental Amendment D, filed 31 October 2003, Applicant added claims 7-10 and introduced additional remarks

Claims 1-4 and 6-10 are pending and are examined.

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R sponds to Arguments

Applicant's arguments filed 9 September 2003 and 31 October 2003 have been fully considered but they are not persuasive.

Applicant argues that amended claims 1 and 6 recite "means for retrieving" searches to locate clients who purchase a single certain type of good [...according to time period, etc.]:

As such, according to the independent claims, Applicant's invention defines and retrieves high-ranking clients who contribute to sales of a particular product. Applicant's apparatus as set forth in claim 1, and Applicant's method as set forth in claim 6, would not have been taught or suggested by the asserted combination of *Anderson, et al.* and *Evans*.

As a preliminary note, only claim 1 contains *means for retrieving results*:

- ...means [] for retrieving results [claim 6: from said (one) *storage means*] representative of high-ranking clients who contribute to sales of a single designated good by setting at least conditions of time period, class of goods and sales rate from the information of the goods purchased; ...

Similarly, the disclosures do not contain the word "single." The word "good (singular) appears as follows. Other references are to goods (plural).

Fig. 2 is a flow chart for storing the good purchase data...

Individual information such as a client code, a name, a postal number, an address, a telephone number of the client, the purchase price within a designated period of the *designated good* and the final date of visit, out of information of clients who have experience to buy the goods obtained as a result of retrieval, are output to the client actual sales list in the form of a table in order, and the total of the goods purchase prices obtained by the retrieval is also displayed.

When the *good* master maintenance 10b is selected, the goods name, vendor, unit price and the like of the goods can be input into the main computer 1.

POS *good* name column 12b, ...

The *good* numbers are entered in the goods code column 12a. With respect to the goods numbers, bar code numbers support

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Cancelled claim 5: ...advertised to a main computer, selecting a *class* whether *retrieval* is made by a company, a department or the *good* and carrying out the *retrieval* in the selected *class*...

Applicant argues that the references do not teach analysis based on individual products, merely clustering (applicant's goods class) and cluster-level analysis:

To those of ordinary skill in the art, Anderson, et al. clearly teach clustering. In regard to independent claims 1 and 6, Anderson, et al. teach database construction and analysis with product clusters, not individual products. For instance, column 10, lines 42-46 of Anderson, et al. specifically teach, to those of ordinary skill in the art, that the database stores for each client, purchase dates, amounts, and discounts for "various product clusters rather than specific products". In the same column, immediately above, Anderson, et al. give examples of such product clusters to those of ordinary skill. See column 10, lines 22-27 which instruct assigning a particular brand of soda into a cluster defined as beverages, and which instruct assigning a particular brand of cat food into a cluster entitled pet foods. Such clustering leads those of ordinary skill in the art to a completely different result than what the Applicant accomplishes. Amendment C.

The Examiner respectfully notes that applicant appears to ignore portions that clearly show that Anderson collects specific transactional and historical data for specific individuals and specific products. In particular, Applicant relies on the following text to show that Anderson does not teach product-level analysis:

...In this way, the database stores for each customer MIN transaction purchase dates, amounts and discounts for various product clusters rather than specific products. Col. 10, lines 42-46.

Per Applicant admission, the Examiner respectfully notes that the selected portion of Anderson clearly teaches analysis at the level of a specific product. Anderson also provides means for storing and retrieving data according to specific products, time periods and classes of goods. For example:

Product, consumer and transactional data are maintained in a relational database (Abstract)

An integrated system is required which allows individual retailers to determine buying patterns and habits of clients to determine client needs and preferences with respect to retail products sold. Such a system must accumulate transactional data, provide meaningful analysis, and allow retailers to target specific consumers based on determined buying patterns and preferences with promotional and advertising literature tailored to preferences and needs. To achieve those goals, such a system must be capable of inputting and categorizing enormous amounts of consumer and product data,

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organizing that data in a logical fashion, and providing data analysis useful for marketing and advertising. Col. 2, lines 39-55, emphasis added.

Product, consumer, and transactional data are maintained in a relational database. Targeting of specific consumers with marketing and other promotional literature is based on consumer buying habits, needs, demographics, etc. A retailer queries the relational database using selected criteria, accumulates data generated by the database in response to that query, and makes business and marketing decisions based on that accumulated data. Col. 3, lines 1-7, emphasis added

FSDB Data Store Main repository for consumer characteristics and transactional purchase history. (Col. 13, lines 20-28).

PURCHASE Data Flow The actual transaction between a retail grocer and one of their consumers. (Co. 13, lines 58-60).

TRANSACTION SESSION Data Flow A set of transactions representing the total "check-out" interaction between the retail grocer and one of their consumers at one time. Includes purchases, voids, and all other activity conducted at the POS workstation. (Col. 14, lines 8-14)

Thus, even if one were to find enablement in applicant's disclosures for retrieving results "...representative of high-ranking clients who contribute to sales of a single designated good..." it is clear from at least the above quoted portions that *Anderson* provides the same capability.

Applicant argues that the references do not teach analysis based on individual products, and that his invention

...encourages sales promotion based wholly on purchase histories, i.e., fact, as opposed to conventional marketing promotion techniques involving assumptions...Applicant cites *Anderson* as an example of such conventional methods where assumptions are made based upon client characteristics such as age, annual income, hobbies, tastes and the like. In many cases, these selected criteria may offer good results. However, they still do not fully reflect the actual behavior of such purchasers. To the contrary, Applicant's apparatus and method execute searching based only upon factual histories, that is, only upon purchase records for selected, particular products. Amendments C, D.

Again, the Examiner respectfully notes that applicant appears to ignore other portions that clearly show applicant's claims. For example, see at least:

...A third table is a consumer *history* including entries such as the time spent by a *particular client* in each store, the money spent per store visit, any discounts acquired per store visit, etc. In this way, the database stores for each customer MIN transaction purchase dates, amounts and

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discounts for various product clusters rather than specific products. Col. 10, lines 40-46, emphasis added.

FREQUENT SHOPPER DATA BASE consumer information from consumer application subsystem and add to database. Data Store Main repository for consumer characteristics and product purchase history. Relational database serving as repository for consumer and product information. (Anderson, Col. 23, lines 48-53, emphasis added))

Applicant's Supplemental Amendment D fails to cure applicant's claims.

Anderson refers to product clusters, as Applicant correctly admits. However, applicant's references to Charts 1-2 and 1-1 continue to disregard Anderson's references to specific products within product clusters (see at least Abstract, Col. 2, line 56-Col. 3, line 8, Col. 10, lines 42-45).

Applicant characterizes his invention as "...sales promotion based on fact..." and argues that Anderson is a "...sales promotion according to supposition. Applicant presents two charts in support of his new arguments:

First, attention is invited to **Chart 1-2**. Applicant submits this Chart as showing a conventional sales promotion method. Applicant characterizes the *Anderson* method as of this conventional type. According to Applicant, the conventional method makes assumptions based upon conditions of clients. For example, age, annual income, hobbies, tastes, and the like are considered. However, also according to Applicant, such selected conditions do not fully correspond to the actual behavior of the client. Applicant illustrates this in Chart 1-2 by the broken line step "STUDY AND DECIDE CONDITIONS OF 'SUCH CLIENTS'". This step is illustrated further in the two other broken-line steps shown to its right.

Applicant respectfully urges that he has taken a completely different approach. Rather than basing sales promotion on assumptions as does the conventional method, Applicant's claimed apparatus and Applicant's claimed method rely only upon facts.

Please now refer to **Chart 1-1**. It should be understood that Applicant's Chart 1-1 illustrates an overall sales promotion strategy, which strategy includes the present invention. Within Chart 1-1, focus on the "EXECUTE SEARCHING" step, and the steps shown to the immediate right of the "EXECUTE SEARCHING" step. In the right-hand steps, Applicant has labeled the upper block as "Step 1". This "Step 1" involves calculation of the set amount, M , for each good, that is $M = A \times R$. Once the amount, M , has been calculated, advance is made to "Step 2". Here, Applicant's invention extracts high-ranking clients for a designated good. This is done according to the teachings of Applicant's original disclosure, by identifying those relatively few (actually the fewest) clients who account for the dollar/yen amount, M , purchased. After this has been accomplished, it is seen that advance can be made to the "PROVIDE LIST OF CLIENTS WHO HAVE REPEATED BUYING" step. Applicant's presently claimed invention is central to identifying "high-ranking clients" in Applicant's overall strategy.

At the onset, the Examiner also respectfully notes that none of the above features appear in the claims. Please see also objection to new matter. Further, the Examiner notes that Anderson discloses targeting customers based on facts. See, for example, at least references to determining customers who spend the most money (1) overall, ... (3) particular time of year, for example, Col. 10, lines 11-65. Therefore, applicant's characterization of Anderson are not persuasive.

In addition, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Please note that Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Notes Concerning Official Notice and Travers

A "traverse" is a denial of an opposing party's allegations of fact.¹ The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. See also MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of this, the following is admitted prior art:

...targeting those clients that provide a business with sales over a percentage such as 80% makes it possible to apply well-known rules to selecting their best clients.

¹ Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

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...it would be less effective to send promotional materials to customers who have purchased minimal quantities of a product class. For example, one would be less likely to target customers whose purchases have decreased from 0.001 percent to 0.0005 percent of a class of goods, while one would be more likely to send marketing materials and coupons to customers whose purchases have increased from 40% to 60% of seller's total for the class of goods.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

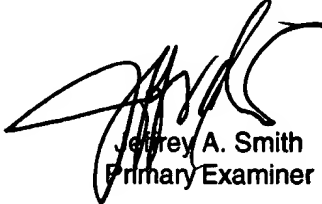
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
12 April 2004


Jeffrey A. Smith
Primary Examiner